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REMARKS

For the record, however, the Examiner, in paragraph 3 of the Final Action, rejects claims 1, 2, 4-8 and 10-15 for the first time as unpatentable over Brander '269 in view of Brander '973, and refers to paragraph 10 of the Office Action mailed November 8, 2002, which involved the rejection of only claims 3 and 9. There is nothing in paragraph 3 of the Final Action that properly communicates the reasoning or basis for the rejection that claims 1, 2, 4-8 and 10-15 are obvious based on a combination of the Brander references. This is clearly improper, as confirmed by MPEP §706.02(j), a copy of which is attached for consideration by the Examiner.

Furthermore, the Examiner states that Applicants have not fully addressed the rejection stated in paragraph 10 of the November 8, 2002 Office Action. Paragraph 10 expressed a rejection of only claims 3 and 9, in which the Examiner focused the rejection on the claim recitations of "lake sand." Applicants replied to the rejection of claims 3 and 9 and had no notice that anything the Examiner stated in paragraph 10 applied to claims 1, 2, 4-8 and 10-15.

The Examiner has failed to meet the requirements of MPEP §706.02(j) with regard to the manner in which Brander '269 and Brander '973 rendered Applicants' claims 1, 2, 4-8 and 10-15 obvious. It is clearly improper for the Examiner to state that *prima facie* obviousness has been established when Applicants have not been given a fair basis to understand and reply to the Examiner's rejection, which has not been properly communicated. In addition, clearly, the Declaration of Stephen Baker overcame any conclusion of *prima facie* obviousness of claims 1, 2, 4-8 and 10-15, based on Brander '269, the only obviousness rejection of claims 1, 2, 4-8 and 10-15 to which Applicants have been given a fair opportunity to reply.

The final rejection of claims 1, 2, 4-8 and 10-15 as obvious in view of Brander '269 and Brander '973 is premature, and should not have been entered. Claims 1, 2, 4-8 and 10-15 are not *prima facie* obvious.

Respectfully submitted,



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## EXAMINATION OF APPLICATIONS

706.02(k)

**706.02(j) Contents of a 35 U.S.C. 103 Rejection**

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.

(B) the difference or differences in the claim over the applied reference(s).

(C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd.

Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections.

Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply. Furthermore, if an initially rejected application issues as a patent, the rationale behind an earlier rejection may be important in interpreting the scope of the patent claims. Since issued patents are presumed valid (35 U.S.C. 282) and constitute a property right (35 U.S.C. 261), the written record must be clear as to the basis for the grant. Since patent examiners cannot normally be compelled to testify in legal proceedings regarding their mental processes (see MPEP § 1701.01), it is important that the written record clearly explain the rationale for decisions made during prosecution of the application.

See MPEP § 2141 - § 2144.09 generally for guidance on patentability determinations under 35 U.S.C. 103, including a discussion of the requirements of *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). See MPEP § 2145 for consideration of applicant's rebuttal arguments. See MPEP § 706.02(l) - § 706.02(l)(3) for a discussion of prior art disqualified under 35 U.S.C. 103(c).

**706.02(k) Provisional Rejection (Obviousness) Under 35 U.S.C. 102(e)/103**

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.59(b), continued prosecution applications filed under 37 CFR 1.53(d), and reissues. The amendment to 35 U.S.C. 103(c)